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REMARKS

Claims 1-18 are currently pending in the subject application and are presently under consideration. The specification and claims have been amended herein. Independent claims 1, 10 and 15 have been amended to incorporate the limitations of claims 4, 11 and 16, respectively. As a consequence, claims 4, 11 and 16 have been cancelled without prejudice or disclaimer. Claims 19 and 20 have been added to further clarify applicant's claimed invention. No new issues are raised. All pending claims are at pages 2-8. Favorable consideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Amendments to the Specification

The Specification has been amended herein to resolve a typographical error.

II. New Claims

Claims 19 and 20 have been added herein to further clarify the claimed invention. Both claims recite limitations similar to the limitations of claims 1-18. No issues have been raised that would require a further prior art search.

III. Rejection of Claims 1-18 Under 35 U.S.C. § 103(a)

Claims 1-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Edel, *et al.* (US 4,891,771) in view of Truelson (US 6,223,191). It is respectfully submitted that this rejection should be withdrawn for at least the following reason. Edel, *et al.* and Truelson, individually or in combination, do not teach or suggest *all* the claim limitations.

To reject claims in an application under §103, an examiner must establish three basic criteria: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and finally, the prior art reference (or references when combined) *must teach or suggest all* the claim limitations. See MPEP §706.02(j).

Independent claims 1, 10 and 15 have been amended herein to recite the limitations of claim 4, 11 and 16, respectively, regarding balancing text on a page on *a rolling pair of lines-by-*

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rolling pair of lines basis. Since a prior art search has already been performed on dependent claims 4, 11 and 16, the amendments do *not* introduce new issues; and thus, no further prior art search is needed. Independent claims 7, 9 and 14 recite similar limitations regarding balancing text on a page on *a rolling pair of lines-by-rolling pair of lines basis*. Edel, *et al.* and Truelson, alone or in combination, do not teach or suggest balancing text on a page on *a rolling pair of lines-by-rolling pair of lines basis*, as recited in the subject claims. Since, Edel, *et al.* and Truelson do not teach or suggest *all* claim limitations, Edel, *et al.* in view of Truelson does not make obvious the subject claims.

In particular, and as disclosed in the subject application, balancing text on *a rolling pair of lines-by-rolling pair of lines basis* includes determining whether the length of a first line of text is less than the length of a next line of text. Neither Edel, *et al.* nor Truelson teach or suggest such claimed aspects. In the Office Action (dated June 27, 2003), the Examiner confirms that "Edel, *et al.* and Truelson do not explicitly teach determining if a first line is less than a second line in length." (See Office Action, page 3, No. 8). It is then contended in the Office Action that Truelson discloses a data structure with line length information and that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Truelson to extract such information and compare the lengths of two lines in order to provide another means to determine if a word segment should be moved from a line. However, the mere fact that the reference can be modified does not render the modification obvious unless the cited art also *suggests the desirability* of the modification. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). MPEP §2143.01. It appears that the Examiner is modifying the reference *via* employment of applicant's specification on a 20/20 hindsight (blueprint) based reading to provide this missing teaching. *Interconnect Planning Corporation v. Thomas E. Feil, Robert O. Carpenter, V Band Systems, Inc., and Turret Equipment Corp.*, 774 F.2d 1132, 1138 (C.A.Fed. 1985.); 227 USPQ 543 (stating the invention must be viewed *not* with the blueprint drawn by the inventor, but in the state of the art that existed at the time). See also *Stewart-Warner Corp. v. City of Pontiac, Michigan*, 767 F.2d 1563, 1570 (Fed.Cir.1985), 226 USPQ 676, 680-81.

Truelson provides *no* motivation, suggestion or desirability to utilize such a comparison for balancing text on a rolling pair of lines-by-rolling pair of lines basis as recited in the subject claims. As disclosed, Truelson balances lines of text based on a set of a *preceding* (not succeeding) balanced line(s) and then determines final group balancing based on an aggregate

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weight of the *preceding* balanced lines of text. In contrast, the subject claims recite balancing on a rolling pair of lines-by-rolling pair of lines basis, which *requires balancing a line of text based on a succeeding line of text* (e.g., determining whether the length of a first line of text is less than the length of a next line of text). Thus, the principle of operation of Truelson, balancing a line of text based on a set of a *preceding* balanced line(s) of text, would have to be modified; and therefore, Truelson lacks motivation and desirability for such modification. *See MPEP §2143.01* (if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)).

It is further contended in the Office Action that Truelson discloses a method to determine if the letter spacing of a first line exceeds a letter spacing threshold. However, Truelson utilizes letter spacing criteria only when the text is right/left justified wherein the lines of text are the *same* length and comparing lines of text of the same length does not provide useful length difference information. Truelson, states that when the text is simply left justified with a "ragged" right margin, letter space would be "omitted" or "substantially different" since word spacing within a line would be the "*same*." (*See col. 7, lines 27-30*) (Emphasis added). Thus, in light of Truelson's disclosure, determining if line letter spacing exceeds a letter spacing threshold is utilized when balancing right/left justified groups of words of equal line length, which does not teach or suggest the subject claims.

In view of the foregoing, it is respectfully requested that the rejection of independent claims 1, 7, 9, 10, 14 and 15, and dependent claims 2-3, 5-6, 8, 10, 12-13, and 17-18, which respectively depend therefrom, be withdrawn.

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CONCLUSION

The present application is believed to be in condition for allowance, in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,

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